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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,649

01/27/2004

Younger Ahluwalia

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05/23/2006

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/766,649

Applicant(s)

AHLUWALIA ET AL.

Examiner

Victor S. Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-6, 8-12, 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/28/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' remarks filed on 2/7/2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, in view of Applicants' argument "The presently claimed composite material comprises at least a first and a second layer, wherein the second layer is a metallic component and wherein the second layer is adhered to the first layer ... is not found ... in Horner Jr. et al. or Zucker et al. ..." (Remarks, page 5), the Zucker reference is withdrawn. However, an additional search is required. The new references are found to render obvious the instant claimed invention. Applicant's comments regarding the prior art are moot in view of the new grounds of rejection.

### ***Terminal Disclaimer***

4. The terminal disclaimer filed on 2/7/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of copending US Applications 10/766,652, 10/766,654, and 10/766, 678 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Rejections Based on Prior Art***

5. Claims 1, 7, 13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horner, Jr. et al. (US 6365533) in view of Lynn et al. (US 6093481) and Morgan et al. (US 3062682).

Horner's invention relates to a foamed facer for an insulation board. The facer comprises a fiber mat containing a binder for the fibers, and coated with a prefoamed composition which contains a thixotropic polymer latex, a foam sustaining surfactant, and a filler (column 3, lines 1-14), such as clays, etc. (column 3, lines 45-46). One of the first and second facers can be of the same or of a different composition. (column 6, lines 3-10).

For claims 1, 7, 13 and 16-20, Horner lacks teachings of: (1) a metallic layer is adhered to the foamed facer; and (2) the foamed facer comprises a prefabricated microcells. Regarding the metallic layer, it is noted that Lynn's invention is directed to an insulation board with one or two facing sheets to form a singly or doubly faced composite. In Fig. 4, Lynn shows a laminated facer comprising an outer metallic, preferably aluminum foil 32, layer (column 5, lines 14-16), and Lynn teaches that the impermeable aluminum foil provides an especially high insulation value (column 1, lines 32-33). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art of insulation board to laminate (adhere) a layer of aluminum foil to the outer surface of the foamed facer of Horner, motivated by the desire to obtain improved insulation value, as taught by Lynn. As to the prefabricated microcells, it is noted that Morgan's invention relates to a product composed of mineral

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fibers associated with a foamed material as insulating materials (column 1, lines 11-22), and Morgan teaches that suitable fillers include resinous microballoons (prefabricated microcells), glass beads, clays, etc. (column 13, lines 62-63). As such, in the absence of unexpected results, it would have been obvious to one skilled in the art to also incorporate microballoons in the prefoamed composition of Horner as a filler material, as taught by Morgan. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.


### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

5/18/2006